

### **REMARKS**

Favorable reconsideration of this application as presently amended is respectfully requested. Claims 1-31 are pending in this application, and claims 1 and 16-31 have been cancelled on the basis of having been withdrawn from consideration. In this Amendment, claim 2 has been amended. No new matter is added.

#### **Claim Rejections – 35 USC §112**

Claims 3 and 6 stand rejected under 35 U.S.C. 112, first paragraph, because the specification, while being possibly enabling for suppressing saturation of the base paper with the saturant containing the conductive agent having a viscosity between 20 and 200 cps at 100 degrees Brookfield viscometer does not reasonably provide enablement for saturants outside the disclosed viscosity. The examiner further states that the disclosure does not define what constitutes “suppressing” the saturation of the paper by the saturant, while not suppressing the delivery of the anti-static agent to the interstices of the fibrous base paper.

Synonyms for suppress are inhibit, subdue, to repress, and stifle. The word suppress is not synonymous with words like, preclude, prevent, stop. The suppressing of the saturation indicates that the saturant’s penetration into the base paper falls short of complete saturation and thus the delivery of the anti-static agent must be less than total. This results in a range of delivery of the anti-static agent from complete at the surfaces to which the saturant is applied to less than complete in the interior of the base paper. The suppression must, however, not be so great as to totally preclude anti-static agent from migrating to the interstices of the fibrous paper. Thus, the anti-static agent enters interstices, but not totally. The result is an anti-static paper that uses less anti-static agent than a completely saturated paper. The amount of anti-static agent used is reduced by the present invention without reducing the efficacy of the anti-static quality of the paper. This the result of suppressing saturation. At the outer regions saturation would be complete, while in the interior regions, since the effect of using a saturation suppress does not stop migration of anti-static agent into the paper, but causes delivery of antistatic agent to decrease with increasing distance from the point of delivery of the anti-agent (the surface of the paper). It is thus seen that by suppressing saturation, penetration of the saturant and the anti-static agent into the interior of the paper is less than complete.

The examiner further states that there is no disclosure of what spindle was used in measuring the Brookfield viscosity and what rpm(s) were when the measurement was made. The examiner has not, however, provided any technical information to support this position, and it is respectfully submitted that the examiner's position is in error. The information provided is sufficient to enable one of ordinary skill in the art use viscosity as a guide for suppressing saturation.

#### **Claim Rejections – 35 USC §102**

Claims 2 and 3 stand rejected under 35 USC 102(b), as being anticipated by or, in the alternative, under 35 USC 103(a) as obvious over Finch (2,310,946). The examiner's position that "the present claims are open to a conductive base sheet by virtue of the "comprising" claim language and the recitation of "anti-static paper" in the preamble of the claim does not impart further patentable weight to the claim since it is merely a statement of intended use of an electrically conductive paper. It is respectfully submitted that the examiner is overlooking the recitation in the body of the claims "depositing said anti-static agent . . .".

The examiner states that the Finch process applies a coating containing the conductive metal particles uniformly coats or covers the surface of the and therefore there is a depositing of the particles in at least some of the interstices of the paper at its surface.

The Finch product requires a surface coating of particles, in a uniform coating all over the thickness of the paper.

Finch states, "[a]ccording to my present invention I employ a rag paper which in its original manufacture is saturated with as much powdered conducting metal, such as lampblack, for example, as it can hold". (column 1, lines 28-32). The Finch system provides a paper that is saturated with a conducting metal. Finch further states in column 2, lines 8-15, "I have further discovered that it is preferable that the application of the coating to the black paper be provided by means of a special printing apparatus to be described hereinafter although I may in some cases spray the coating on. In the latter case, however, I have found a tendency for the composition to penetrate the paper".

Claims 2 and 3 are method claims and Finch does not teach a **process** of restricting penetration through the use of a saturation suppressant. Finch's answer to the problem of penetration of the coating into the paper is to use a printing process. Moreover, Finch starts with a paper saturated with a conducting metal. Very simply, the Finch patent does

not teach the **step** of “treating said fibrous base paper with a saturant, said saturant comprising a solution of an anti-static agent, and a liquid carrier . . .”.

With respect to claim 3, Finch does not disclosure the use of “a viscosity increasing agent, having a viscosity in the range that suppresses saturation of said base paper . . .”. This step is not found in Finch and it cannot be seen how this step would serve any purpose in the Finch system. The relevancy of the examiner’s statement that Finch anticipates or shows the claimed product is not understood, since claims 2 and 3 are method claims. Moreover, the two products are dramatically different. The Finch product is saturated with metal and in addition has a surface coating of a metal. The instant product is a paper that contains less than a saturated level of a conductive material and, in addition, the concentration of the conductive material decreases progressively from the surface to the interior.

Claims 2-4, 6, and 8-15 stand rejected as anticipated, or in the alternative, obvious over Armington et al (4,806,410). Claim 3 has been cancelled and the limitations of claim 3 have been incorporated into claim 2. The examiner acknowledges that Armington et al squeezes the liquid into the paper. This step would not only deposit anti-static agents into the paper, but would saturate the paper. Thus, Armington teaches away from the present invention, in which a suppressant is used to prevent saturation of the paper with anti-static agent.

Claims 5 and 7 stand rejected under 35 USC 103(a) as being unpatentable over Armington et al.

Claims 4-15 are patentable for the reasons set forth in regard to claim 2. If the Examiner has any questions or concerns regarding the present response, the Examiner is invited to contact Sheldon H. Parker at 703-563-2041.

In view of the foregoing, it is respectfully submitted that this application is in condition for allowance, and favorable action is respectfully solicited.

Respectfully submitted,  
**JAGTIANI+ GUTTAG**



Sheldon H. Parker  
Registration No. 20,738



JAGTIANI+GUTTAG  
10363-A Democracy Lane  
Fairfax, VA 22030  
(703) 563-2041

*February 7, 2006*  
~~January 7, 2006~~

Certificate of mailing under 37 CFR 1.8

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to:

Commissioner for Patents

P.O. Box 1450

Alexandria, VA 22313-1450

~~On January 7, 2006~~

*February 7<sup>th</sup> 2006*



Sheldon H. Parker